

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Milwaukee Electric Tool Corporation,

Petitioner,

v.

Klein Tools, Inc.,
Patent Owner

U.S. PATENT NO. 11,452,327

Case No. IPR2025-00724

**PATENT OWNER'S REQUEST FOR
DISCRETIONARY DENIAL OF *INTER PARTES REVIEW***

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<u>Exhibit #</u>	<u>Description</u>
2001	United States Patent Application Publication No. 2019/0008228, Issued to Ramey, January 10, 2019
2002	United States Patent No. 6,497,493, Issued to Theisen, December 24, 2002
2003	Complaint for Patent Infringement, <i>Klein Tools, Inc. v. Milwaukee Electric Tool Corp.</i> , Case No. 25-cv-00143, February 4, 2025, Docket No. 1
2004	Email between Counsel re Motion to Stay, dated between March 24-25, 2025
2005	Defendant's Unopposed Motion to Stay Pursuant to 28 U.S.C. § 1659 and for an Extension of Time to Respond to the Complaint, <i>Klein Tools, Inc. v. Milwaukee Electric Tool Corp.</i> , Case No. 25-cv-00143, March 27, 2025, Docket No.11
2006	Order Granting Motion to Stay, <i>Klein Tools, Inc. v. Milwaukee Electric Tool Corp.</i> , Case No. 25-cv-00143, March 28, 2025, Docket No. 12
2007	Order No. 7: Procedural Schedule, In the Matter of Certain Glow Fish Tape Systems, Safety Helmet Systems, and Components Thereof, Investigation No. 337-TA-1442, May 1, 2025
2008	United States Patent and Trademark Office Memorandum re Interim Processes for PTAB Workload Management, March 26, 2025
2009	First Amended Complaint under Section 337 of the Tariff Act of 1930, as Amended, In the Matter of Certain Glow Fish Tape Systems, Safety Helmet Systems, and Components Thereof, Investigation No. 337-TA-1442, May 5, 2025

<u>Exhibit #</u>	<u>Description</u>
2010	Excerpt from First Supplemental Hard Hat Domestic Industry Claim Chart for U.S. Patent No. 11,452,327, In the Matter of Certain Glow Fish Tape Systems, Safety Helmet Systems, and Components Thereof, Investigation No. 337-TA-1442
2011	Excerpts from Respondents’ Fifth Supplemental Objections and Responses to Complainant Klein Tools, Inc.’s First Set of Interrogatories, In the Matter of Certain Glow Fish Tape Systems, Safety Helmet Systems, and Components Thereof, Investigation No. 337-TA-1442, July 1, 2025
2012	United States Patent and Trademark Office FAQs for Interim Processes for PTAB Workload Management
2013	United States Patent and Trademark Office Memorandum re Guidance on USPTO’s recession of “Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation, March 24, 2025

I. INTRODUCTION

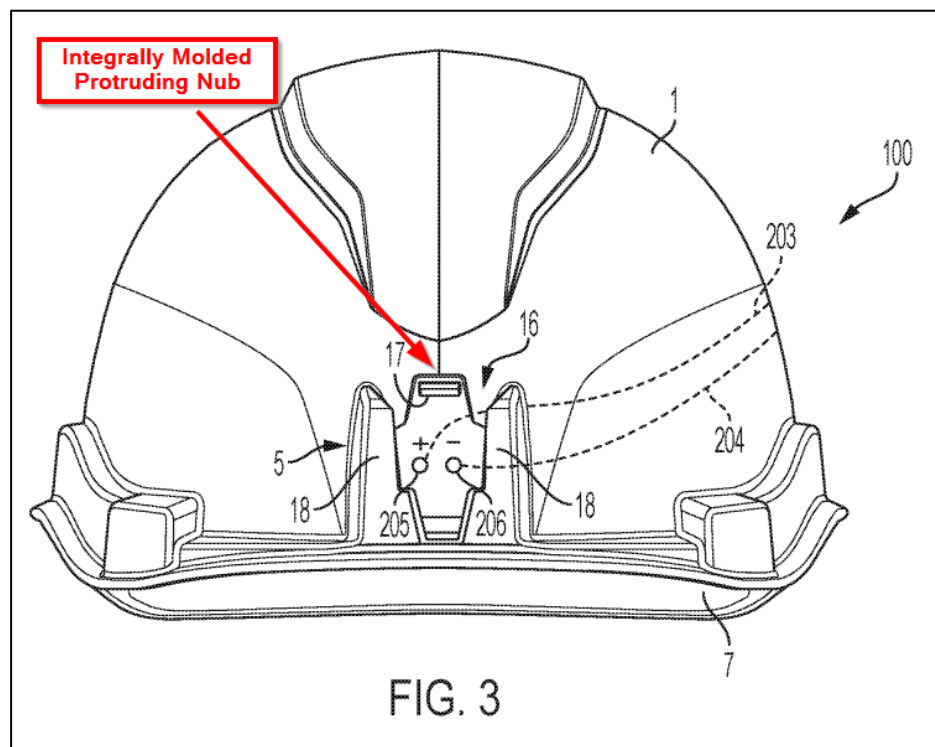
A parallel ITC investigation involving this same patent, parties, prior art, claims, and grounds is set to complete trial one year before the PTAB would issue its final written decision, with the ITC investigation entirely concluding five months before the PTAB would issue its final written decision. Notably, in two IPRs involving the same parties as involved here, albeit in opposite roles, the Director recently exercised her discretion to deny institution on nearly identical facts. *See Klein Tools, Inc. v. Milwaukee Electric Tool Corporation*, IPR2024-01400, Paper 22 at 2-3 (June 11, 2025) (Director Stewart reversing Board decision to grant institution based on parallel ITC proceeding under *Fintiv* where the “ITC ... is scheduled to issue a final determination six months before the statutory deadline for the Board’s written decision”). Unlike the grounds presented in *Klein Tools v. Milwaukee*, the grounds presented in this petition are weak, including as evidenced by Petitioner’s extensive reliance on expert testimony. And, finally, many of Petitioner’s arguments were already considered and rejected by the Office, but Petitioner has not established that the Office erred in any material way.

Accordingly, Patent Owner respectfully requests that the Director exercise her discretion and deny institution of this *inter partes* review under 35 U.S.C. §§ 314(a) and 325(d).

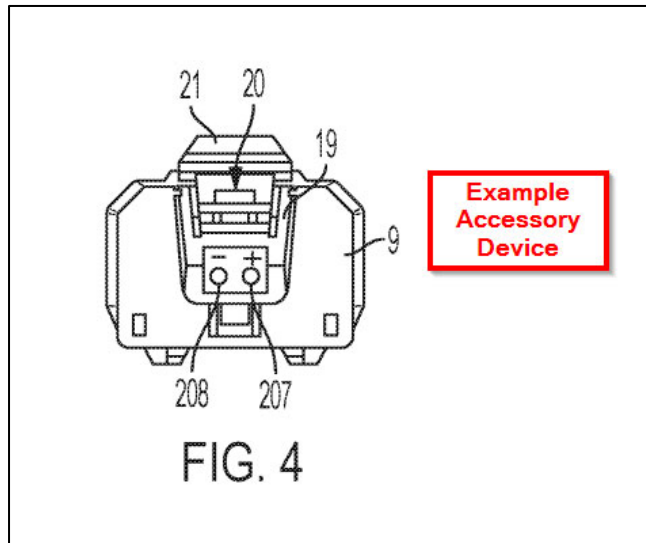
II. BACKGROUND

A. The '327 Patent

The '327 Patent is related to safety helmets, commonly referred to as “hard hats.” Ex-1001 at 1:16-17. The invention of the '327 Patent relates to, among other things, safety helmet systems, including safety helmets, a category that includes hard hats, with an outer shell including a brim, a front receptacle, a rear receptacle, and accessory device(s) that are designed to be releasably mountable onto at least a portion of each of the front and rear receptacles. The preferred embodiment is depicted below:



Id. at Fig. 3 (annotated).



Id. at Fig. 4 (annotated).

B. '327 Prosecution History

The Claims of the '327 Patent were subject to multiple office actions. *See* Ex-1004 (Prosecution History). In a November 24, 2021 Office Action ("November 2021 Office Action"), the Examiner rejected all then-pending claims (1-6, 13, 21, 23, and 25-32) as unpatentable over Ramey (Ex. 2001) in view of Theisen (Ex. 2002). *See* Ex-1004 at 126-134. According to the Examiner, "Ramey teaches multiple attachment receptacles on a helmet that can be any device now known or later developed." *Id.* at 132. In Ramey, these platforms are formed as separate pieces and attached to the helmet using fasteners (e.g., rivets, screws), not as unitary or integral features of the helmet shell. *See id.* at 79. The Examiner also stated that Theisen teaches a safety helmet with a receptacle (attachment bracket) that can be

either attached to the already formed outer shell or molded into the outer shell, making the receptacle unitary with and formed from the shell. *See id.* at 132.

The Examiner then combined Ramey and Theisen to reject the claims, stating that it would have been obvious to one of ordinary skill in the art to replace Ramey's separately attached mounting means with Theisen's molded, unitary attachment means, thereby providing a helmet that can securely attach accessories without compromising the helmet's integrity. *Id.* (Examiner stating that "[r]eplacing the attachment receptacles of Ramey with the molded attachment receptacles of Theisen creates a helmet with multiple integrally molded attachment receptacles that are located along the front and rear of the helmet above the brims and of identical construction.").

On March 29, 2022, the Applicant initiated an interview ("March 2022 Interview"). *See id.* at 84. The interview summary reflects that the Applicant and Examiner discussed, in relevant part, "ways to overcome the 103 rejection of Ramey [] in view of Theisen [] by detailing that the outer shell and the nub are formed of the same unitary/integral material and that the nub is located at the upper portion of the receptacle." *Id.* at 84 (citations omitted).

In response to the office action and in light of the interview, on April 25, 2022 Applicant filed a response ("April 2022 Response") (i) amending the claims "for clarity" to replace the words "unitary feature" and "integral" with "integrally molded

... from the common material” or a “common material” for clarity and (ii) submitting a Rule 1.132 declaration from James O. Hill (“Hill Declaration”) in support of its arguments, including evidence of non-obviousness. *Id.* at 42-81.

The Examiner allowed the application on May 12, 2022. *Id.* at 18-20.

C. The Parallel, Fast-Moving ITC Investigation

Patent Owner and Petitioner are parties to two parallel proceedings concerning the '327 Patent: ITC Investigation No. 337-TC-1442 (the “Parallel ITC Investigation”) and District of Delaware Case No. 1:25-cv-00143-JLH (the “District Court Case”) since February of 2025. *See* Ex. 1016; Ex. 2003. Petitioner informed Patent Owner of its intention to file its request for a “mandatory” 28 U.S.C. § 1659 stay of the District Court Case pending resolution of the Parallel ITC Investigation, which Patent Owner did not oppose, and the District Court granted. *See* Exs. 2004; 2005; 2006. The purpose of a § 1659 stay is to “avoid[] litigation in two forums at once.” *In re Princo Corp.*, 478 F.3d 1345, 1355 (Fed. Cir. 2007).

The Parallel ITC Investigation is already at an advanced stage. Claim construction is fully briefed, and the parties will argue the issues next week. Ex. 2007. The parties are less a month away from the fact discovery cutoff and completion. Ex. 2007 at 2. Indeed, the parties have collectively served 44 interrogatories (even more when discrete subparts are counted), supplemented their interrogatory answers a total of 11 times, produced 44,900 pages of documents, and

started depositions. Trial is less than four months away, starting on November 17, 2025 and finishing no later than November 21, 2025. Ex. 2007 at 3. The Chief ALJ is slated to release his final initial determination on February 18, 2026, and the Commission is scheduled to complete its investigation by June 18, 2026. *Id.* at 3.

D. This IPR's Schedule

The Preliminary Patent Owner Response is due on August 21, 2025. *See* Paper 5 at 1. The Board's decision on whether to institute *inter partes* review will therefore be due on November 21, 2025—the same day trial is set to finish in the Parallel ITC Investigation. *See* Ex. 2007 at 3. Assuming *inter partes* review is instituted (it should not be), the Board's final written decision would be due on November 21, 2026—over five months after the completion of the Parallel ITC Investigation. *See id.* at 3.

III. DISCRETIONARY DENIAL CONSIDERATIONS

On March 26, 2025, Director Coke Morgan Stewart issued and signed a memorandum titled “Interim Processes for PTAB Workload Management” (the “March 26 Memo”). The March 26 Memo provides for a bifurcation between requests for discretionary denials and requests for merits-based denials. *See* Ex. 2008 at 1. The March 26 Memo explains that for requests for discretionary denials the

PTAB will consider *Fintiv*¹ factors and other factors, such as “[t]he extent of the petition’s reliance on expert testimony,” and “[s]ettled expectations of the parties.” *Id.* at 2.

Instituting or denying a petition under § 314(a) “is a matter committed to the Patent Office’s discretion.” *Cuozzo Speed Techs., LLC v. Lee*, 579 U.S. 261, 273 (2016); *see also Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) (under § 314(a) “the PTO is permitted, but never compelled, to institute an IPR proceeding”).

When there is a parallel proceeding that “will analyze the same issues and will be resolved before any trial of the Petition concludes,” institution of an IPR trial “would not be consistent with ‘an objective of the AIA ... to provide an effective and efficient alternative to district court litigation.’” *NHK Spring Co. v. Intri-Plex Techs.*, IPR2018-00752, Paper 8 at 20 (Sept. 12, 2018) (precedential) (citations omitted). In *NHK*, the Board used its discretion to deny institution under § 314(a) because a parallel district court proceeding was scheduled to end before the Final Written Decision (“FWD”) deadline and “Petitioner assert[ed] the same prior art and arguments” in that parallel proceeding. *NHK*, IPR2018-00752, Paper 8 at 19-20. The

¹ *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (Mar. 20, 2020) (precedential).

same rationale applies to a parallel ITC investigation. *Fintiv*, IPR2020-00019, Paper 11 at 8 (March 20, 2020) (“[A]n earlier ITC trial date may favor exercising authority to deny institution under *NHK* if the ITC is going to decide the same or substantially similar issues to those presented in the petition.”).

Indeed, the Board has routinely denied institution under *Fintiv* based on a parallel ITC investigation. *E.g.*, *Klein Tools, Inc. v. Milwaukee Electric Tool Corporation*, IPR2024-01400, Paper 22 at 1-4 (June 11, 2025) (Director Stewart reversing Board decision to grant institution based on parallel ITC proceeding under *Fintiv*); *Samsung Electronics Co., Ltd. v. Sionyx, LLC*, IPR2025-00161, Paper 14 at 4-11 (May 21, 2025) (discretionarily denying institution of IPR under *Fintiv* in view of parallel ITC proceeding); *Innoscence America, Inc. v. Infineon Technologies Americas Corp.*, IPR2025-00010, Paper 11 at 5-20 (May 16, 2025) (same); *Arashi Visian (U.S.) LLC D/B/A Insta360 v. GoPro, Inc.*, IPR2025-00017, Paper 11 at 7-16 (April 28, 2025) (same); *Eunsung Global Corp. v. HydraFacial LLC*, IPR2024-01491, Paper 17 at 8-19 (April 11, 2025) (same).

Fintiv articulated six factors to consider in determining whether to exercise discretion to deny institution based on a parallel district court or ITC proceeding: (1) whether the court granted a stay or evidence exists that one may be granted if an IPR proceeding is instituted; (2) proximity of the court’s trial date to the Board’s projected statutory deadline for a FWD; (3) investment in the parallel proceeding by

the court and the parties; (4) overlap between issues raised in the petition and in the parallel proceeding; (5) whether the petitioner and the defendant in the parallel proceeding are the same party; and (6) other circumstances that impact the Board's exercise of discretion, including the merits. *Fintiv*, IPR2020- 00019, Paper 11 at 5-6. These factors are evaluated by taking “a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review.” *Id.*

IV. ARGUMENT

A. All *Fintiv* Factors Weigh Strongly in Favor of Denial

1. Petitioner Has Not Requested a Stay from the ITC, and, in any event, the ITC Would Not Grant One

Petitioner has not requested a stay in the Parallel ITC Investigation. Even if the Petition were instituted, it is highly unlikely that the ITC would issue a stay at this late stage because trial is set to be complete by November 21, 2025—the same day as the deadline for any institution decision here. Ex. 2007 at 3. Moreover, it is extremely unlikely that an ITC proceeding will be stayed pending IPR because the ITC has a statutory mandate under 19 U.S.C. § 1337(b)(1) to conclude its investigation at “the earliest practicable time” and has refused requests, in essentially all instances, to stay investigations pending instituted IPRs. *See, e.g., In the Matter of Certain Automated Storage and Retrieval Systems, Robots, and Components Thereof*, Investigation No. 337-TA-1228, Order No. 6 (Mar. 9, 2021); *In the Matter of Certain Laser-Driven Light Sources, Subsystems Containing Laser-Driven Light*

Sources, and Products Containing Same, Investigation No. 337-TA-983, Order No. 8 (Mar. 3, 2016).

Although the Parallel District Court Litigation is stayed under 28 U.S.C. § 1659 pending the Parallel ITC Investigation, this does not alter the analysis. *See* Ex. 2006. *Fintiv* explains that the focus should be on “whether the patentability disputes before the ITC will resolve all or substantially all of the patentability disputes between the parties, regardless of the [District Court] stay.” *Fintiv*, IPR2020-00019, Paper 11 at 8-9.

The first factor thus weighs in favor of denying institution. *See Eunsung Global Corp. v. Hydrafacial LLC*, IPR2024-01491, Paper 17 at 11 (finding Factor 1 weighs in favor of discretionary denial when there is no evidence that ITC proceedings will be stayed despite stay of the parallel district court litigation).

2. *The ITC Trial is One Year Before the FWD, and the ITC’s Completion of Investigation is Five Months Before the PTAB’s FWD*

The ITC trial will conclude one year before the Board’s FWD deadline, and the ITC’s Completion of Investigation will finish five months before the Board’s FWD deadline. *See* Ex. 2007 at 3. This situation tracks *Arm*, where Director Stewart discretionarily denied institution because “the projected final written decision due date in the Board proceeding is in June 2026” and “[t]he district court’s scheduled trial date [(which is akin to the ITC’s trial date or Completion of Investigation date)]

is January 26, 2026 and the time-to-trial statistics suggest trial will begin ... between March and May 2026.” *Arm Ltd. V. Daedalus Prime LLC*, IPR2025-00207, Paper 10 at 2 (May 16, 2025) (inner quotation marks omitted). Further, the nearly five-month gap between the conclusion of the parallel proceeding (here, the ITC investigation) and the Board’s projected FWD date is larger than in *Fintiv*, where this factor was found to weigh in favor of denial. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 13 (May 13, 2020) (the district court trial was scheduled two months before a projected FWD). The five-month gap is also larger than the gap between the conclusion of an ITC investigation and the Board’s FWD in an IPR where the Board found that this factor favored denial. *Philip Morris Products, S.A. v. Rai Strategic Holdings, Inc.*, IPR2020-00919, Paper 9 at 9 (Nov. 16, 2020) (considering a two-month gap). The second *Fintiv* factor therefore weighs strongly in favor of denial of institution.

3. *All Parties and the ITC Have Invested Heavily in the Parallel ITC Investigation*

The parties’ and the Commission’s investment in the Parallel ITC Investigation is substantial, and therefore this factor weighs heavily in favor of discretionary denial. The substantial work and investment by the parties and the Commission before the Board’s institution determination deadline is demonstrated by the following milestones that will be completed by November 21, 2025:

- case management conferences from May 2025 to trial (November 2025);
- a preliminary case management conference;
- claim construction briefing;
- a claim construction hearing;
- all document production;
- all written discovery (including interrogatories);
- all fact depositions;
- third-party discovery;
- opening and rebuttal expert reports;
- all expert depositions;
- motions *in limine*;
- final exhibit lists;
- final pre-hearing conference; and
- trial (*i.e.*, an evidentiary hearing).

See Ex. 2007. Under less extreme circumstances—where “fact discovery was complete, expert discovery was already underway, final invalidity and infringement contentions had been exchanged, and the district court had issued a *Markman* order” and “nearly all substantive work ***other than the trial itself*** will be complete by the time of th[e] institution date”—the Director held that the parties had “invested” “substantial time and effort” and that this “strongly favors discretionary denial.” *See*

Neogenomics Lab 'ys, Inc. v. Natera, Inc., IPR2025-00455, Paper 13 at 2 (June 12, 2025) (emphasis supplied, brackets in original); *see also, Advanced Micro Devices, Inc. v. Concurrent Ventures, LLC*, IPR2025-00223, Paper 9 at 2 (June 12, 2025) (“[T]he parties have made meaningful investment in the district court proceeding. For example, the parties have exchanged infringement and invalidity contentions, have already conducted over seven months of fact discovery, and a *Markman* hearing is scheduled to occur before the due date for an institution decision.” (internal citations omitted)).

The third *Fintiv* factor thus weighs in favor of denying institution. *See Eunsung*, Paper 17 at 12-13 (finding Factor 3 weighs in favor of discretionary denial where the parties have made substantial investments in view of trial scheduled before the institution decision).

4. *All of the Issues Raised by the IPR Are Present in the Parallel ITC Investigation*

All the grounds Petitioner raises here are present in the Parallel ITC Investigation.² Indeed, Petitioner incorporated its Petition by reference into its ITC

² Petitioner has not filed any *Sotera* (or other) stipulation confirming that it will not pursue in the ITC and in the district court any ground it raised or reasonably could have raised here. Even if Petitioner elects to enter a *Sotera* stipulation, the

interrogatory responses for its substantive obviousness and anticipation arguments on the '327 Patent. *See Fintiv*, IPR2020-00019, Paper 11 at 12 (“[I]f the petition includes the same *or substantially the same* claims, grounds, arguments, and evidence as presented in the parallel proceeding, this fact has favored denial.” (emphasis supplied)). Further, all the claims at issue in the ITC investigation are at issue here. *See* Ex. 2009 at 1; Ex. 2010 at 1. Accordingly, *Fintiv* Factor 4 weighs strongly in favor of denying institution.

5. *The Parties Are Identical*

The same parties involved in this proceeding are also involved in the Parallel ITC Investigation. Ex. 2009 at 1. *Fintiv*, IPR2020-00019, Paper 15 at 15 (May 13,

investment in the parallel proceeding by the parties and the Commission outweighs the impact of such a later-filed stipulation. *Motorola Solutions, Inc. v. Stellar, LLC*, IPR2024-01205, Paper 19 at 2 (Mar. 28, 2025) (Director Stewart reversing Board decision to deny discretionary denial because “[t]he Board did not give enough weight to the investment in the parallel proceeding and gave too much weight to Petitioner’s *Sotera* stipulation (*i.e.*, a stipulation that Petitioner will not pursue in district court any ground it raised or reasonably could have raised in the *inter partes* review (IPR)) and its potential to reduce overlap with the issues raised in the parallel proceeding.”).

2020) (“Because the petitioner and the defendant in the parallel proceeding are the same party, this factor weighs in favor of discretionary denial.”). *Fintiv* Factor 5 strongly favors denial.

6. *The Petitioner’s Patentability Challenge is Weak*

Petitioner’s patentability challenge is weak. Petitioner’s sole anticipation ground—an advertisement picturing Patent Owner’s commercial product—hinges entirely on a priority argument that the Examiner already considered and rejected. But even if Petitioner could overcome this flaw (it cannot), Petitioner has already taken the position before the ITC that Patent Owner’s commercial product ***does not*** practice the ’327 Patent, meaning that Petition cannot meet its burden to show by a preponderance of the evidence the reference is anticipatory. And Petitioner’s remaining grounds are based on two-way, or even three-way, combinations—implicitly conceding the ’327 Patent claims new inventions. Each of Petition’s grounds suffers from serious flaws, all of which confirm the Petition should be discretionarily denied.

a. *Petitioner’s Anticipation Argument*

Petitioner asserts that claims 1–17 are anticipated by “Klein Tools’® New Hard Hats Designed for Pros—Safety, Comfort and Fit” (the “Klein News Release”), but relegates this argument to its fourth ground, revealing that Petitioner’s

own understanding is that the argument lacks merit. Paper 2 at 3. And for good reasons.

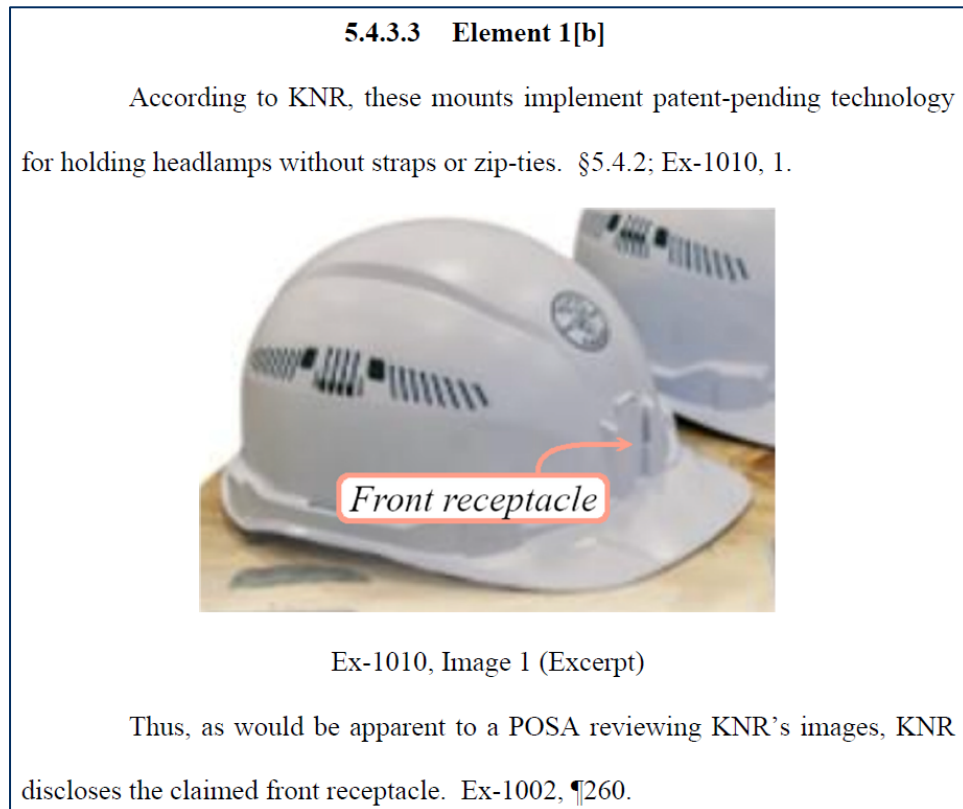
As an initial matter, the Klein News Release is not prior art to the '327 Patent, and so cannot form the basis for a challenge under 35 U.S.C. § 102. *See* 35 U.S.C. § 102(a)(1) (“A person shall be entitled to a patent unless—(1) the claimed invention was patented, described in a printed publication, or in public use, on sale, or otherwise available to the public *before the effective filing date* of the claimed invention.” (emphasis supplied)). Petitioner itself alleges that the Klein News Release was “published July 23, 2019” (Paper 2 at 3), which is more than a year after the filing of the two provisional applications to which the '327 Patent claims priority, and nearly six months after the filing of the non-provisional application that issued as the '327 Patent. Ex. 1001 at 1. Petitioner’s argument thus hinges on its assertion that “the priority date for the Challenged claims is no earlier than October 21, 2021,” purportedly “because new matter was added during prosecution.” Paper 2 at 68–74. But, as discussed further in § IV.C.2 below, the Examiner considered this exact issue during prosecution and determined that the applicants did *not* add new matter. Petitioner has not shown and cannot show that the Examiner materially erred in reaching this determination. *See Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 8 (Feb. 13, 2020)

(precedential). As such, Petitioner’s anticipation argument based on the Klein News Release fails.

Furthermore, Petitioner’s anticipation argument is contingent on a premise that Petitioner itself disputes—*i.e.*, that the products described in the Klein News Release practice the claims of ’327 Patent—and Petitioner thus cannot satisfy its burden. Petitioner characterizes the Klein News Release as “Patent Owner’s own news release describing its *allegedly* patent-practicing helmet” (Paper 2 at 3 (emphasis added)), but Petitioner disputes this allegation in the Parallel ITC Investigation. Ex. 2011 at 138 (“[T]he DI products *do not satisfy at least the following claim elements* in the DI Claims of the ’327 Patent ... ‘a protruding nub.’”) (emphasis supplied). And, consistent with its position in that investigation, Petitioner fails to allege that the Klein News Release discloses a “protruding nub,” despite that element being required by every one of the Challenged Claims.

This glaring—and no doubt intentional—omission can be seen in multiple claim elements. *See* Paper 2 at 78 (addressing element 1[b]), 80–82 (addressing claims 2 and 4), 83 (addressing element 8[b]), 84 (addressing claims 9 and 12), 86 (addressing elements 17[b] and 17[c]). For example, in addressing element 1[b]—which recites “a front receptacle being integrally molded with the outer shell and having an external slot extending upwardly along the front side on the exterior surface of the outer shell above the brim *and a protruding nub, wherein the*

protruding nub is integrally molded with the outer shell from the common material and is disposed centrally relative to the external slot and directly onto the exterior surface of the outer shell”—Petitioner merely refers to “the claimed front receptacle” and makes no mention whatsoever of a “protruding nub”:



Id. at 78. Indeed, despite providing multiple excerpted images from the Klein News Release with annotations indicating various features that map to claimed elements, Petitioner never once indicates the “protruding nub.” *See id.* at 76–81.

While the phrase “protruding nub” appears once—and only once—in the section of the Petition that purports to map the Klein News Release to the Challenged Claims, even there, Petitioner fails to allege that the Klein News Release actually

discloses a protruding nub. Paper 2 at 85. Addressing the portion of element 16[b] that recites “the outer shell forms the protruding nub from a same material as the outer shell,” Petitioner merely states that “[t]his feature would have been apparent to a POSA reviewing KNR”:

5.4.15.2 Element 16[b]

16[b] is similar to 1[b], distinguished by reciting “the outer shell forms the protruding nub from a same material as the outer shell.” This feature would have been apparent to a POSA reviewing KNR. Ex-1002, ¶284.

Id. Petitioner cites the declaration of its expert in support of this vague allegation, but Dr. Reinhall does not opine that the Klein News Release actually discloses a protruding nub, nor does he identify the relevant feature in the images from the Klein News Release. Ex-1002, ¶284. At most, Dr. Reinhall opines that this feature supposedly would have been obvious, as he states that “it would have been apparent to a POSA reviewing the Klein News Release’s images to form a protruding nub from a same material as the outer shell.” *Id.* Petitioner, however, has not presented any obviousness grounds based on the Klein News Release.

Having failed to provide any allegation in its Petition that every element of every one of the Challenged Claims is disclosed by the Klein News Release, Petitioner cannot satisfy its burden prove that the Challenged Claims are anticipated. *Trintec Indus., Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1295 (Fed. Cir. 2002) (“A

single prior art reference anticipates a patent claim if it expressly or inherently describes each and every limitation set forth in the patent claim.”).

b. Petitioner’s Obviousness Arguments

Petitioner’s three obviousness arguments fare no better. In each ground, Petitioner asserts that the Challenged Claims are rendered obvious by “the Yan-Daley helmet,” the “Yan-Daley-Kiessler helmet,” or the “Yan-Nesbitt helmet,” but none of these helmets exist in the alleged prior art. Rather, all are litigation-driven creations of Petitioner reflecting improper hindsight reasoning using the claimed inventions of the ’327 Patent as a roadmap. *Netflix, Inc. v. DivX, LLC*, 80 F.4th 1352, 1358 (Fed. Cir. 2023) (“We analyze whether prior art is analogous with the foresight of a person of ordinary skill, not with the hindsight of the inventor’s successful achievement.”) (citation marks omitted); *In re Cyclobenzaprine Hydrochloride Extended-Release Capsule Pat. Litig.*, 676 F.3d 1063, 1073 (Fed. Cir. 2012) (“This hindsight analysis is inappropriate because obviousness must be assessed at the time the invention was made.”).

Further, Petitioner has failed to show that a POSITA would have been motivated to combine the Yan, Daley, Kiessler, and Nesbitt references as alleged. “The motivation-to-combine inquiry asks whether a skilled artisan ‘not only could have made but would have been motivated to make the combinations ... of prior art to arrive at the claimed invention.’” *Auris Health, Inc. v. Intuitive Surgical*

Operations, Inc., 32 F.4th 1154, 1158 (Fed. Cir. 2022) (quoting *Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1073 (Fed. Cir. 2015) (emphasis omitted)). Every one of the Challenged Claims requires a “protruding nub” that is “integrally molded with the outer shell,”³ but Petitioner’s primary reference—Yan—does not disclose this feature. *See generally* Ex. 1011. Conceding this, Petitioner argues that a POSITA would “modify each of Yan’s snap-fit slot structures” to include a “protrusion,” “groove head,” or “nub,” purportedly because this “would create a more robust securing of the accessories in the snap-fit slot structures” and/or “improve temporarily securing accessories in the snap-fit slot structures.” Paper 2 at 13-14, 43, 48-49. But Yan already describes that its mining lamp and LED lamp are “secured” to the snap-fit slots (Ex-1011 at Abstract; *see also id.* at [0005], [0017], [0027]), and Petitioner does not identify any need for “improv[ing] the temporary security of the snap-fit slots” or providing “more robust securing” that would justify modifying Yan’s slots. Further, there is no evidence that Daley or Nesbitt’s designs

³ Claim 16 uses slightly different language that amounts to the same thing: “wherein the outer shell forms the protruding nub from a same material as the outer shell.” Ex-1001, Claim 16; *see also* Paper 2 at 38 (“Patent Owner uses the term ‘unitary’ interchangeably with ‘formed by’ and ‘integral.’”)

actually provide “more robust securing.” Indeed, Daley, Kiessler, and Nesbitt use virtually identical language to that in Yan, describing their own apparatuses as “temporarily securing the headlight assembly 50 to the shell 22” (Ex-1012 at 5:40-43), “ensur[ing] that the lamp is securely fixed to the helmet” (Ex-1015, [0005]), and “provid[ing] for a secure, albeit detachable, fit” (Ex-1013 at 3:58-60).

Petitioner further argues that integrally molding a “protrusion” or “nub” with the claimed outer shell “would have been cheaper, easier, and allowed for a reduced sales price.” Paper 2 at 13, 48–49. But this would produce the exact opposite result, as the applicants explained during prosecution:

[A] host of different complexities are introduced when attempting to mold more than one structure using a single mold and a single molding operation, for example, addition of molding aids such as at least fillets, draft angles to permit mold separation, gentle radii, plastic flow, and cooling rates.

Ex-1004 at 79; *see also id.* at 80 (“[O]ne of ordinary skill in the art ... would not opt for a more complex molding for the helmet that requires multiple inserts in addition to added complicating factors such as fillets, draft angles to permit mold separation, gentle radii, plastic flow, cooling rates, and other parameters and considerations, to mold the helmet out of a single piece”). Petitioner completely fails to contend with this issue.

In addition, and as discussed further below, Petitioner relies heavily on expert testimony to fill in gaps in the prior art. *See infra* § IV.B.1.

* * *

In any event, even if the Petition does not present weak grounds (it does), the other factors outweigh this one and warrant denial. *See, e.g., Supercell Oy v. Gree, Inc.*, IPR2020-00215, Paper 10 at 18 (June 10, 2020) (“Despite the Petitioner’s strong case on the merits, we determine that the facts underlying factors 2–5 collectively outweigh the facts underlying factor 6[, the merits factor].”); *Klein Tools, Inc.*, IPR2024-01400, Paper 22 at 3 (“With respect to factor 6, under Fintiv’s holistic assessment, the merits of the Petitions do not outweigh the other factors, which all favor denial. Thus, a holistic analysis of all the circumstances demonstrates that the efficiency and integrity of the system are best served by denying institution.” (citation omitted)).

7. *This Case is Nearly Identical to Klein*

In *Klein*, the Director exercised her discretion to reverse the Board’s decision to institute IPR because “the ITC investigation is unlikely to be stayed” and “the ITC ... is scheduled to issue a final written determination six months before the statutory deadline for the Board’s final written decision.” *See Klein Tools, Inc. v. Milwaukee Electric Tool Corporation*, IPR2024-01400, Paper 22 at 2 (June 11, 2025). Further, the Director noted that “the ITC investigation involves the same parties, the same

challenged claims, and includes overlapping prior art references.” *Id.* at 2-3. So too here, the ITC investigation is unlikely to be stayed, and the ITC is scheduled to issue a final written determination five months before the statutory deadline for the Board’s final written decision. *See id.* Indeed, the basis to deny institution here is even stronger as the parties are the same, the challenged claims are the same, and the prior art references are identical (indeed the grounds themselves are identical), not just overlapping as they were in *Klein*. *See id.* Further like *Klein*, by the time the institution decision is due the ITC evidentiary hearing will be complete. *Id.* at 2. And unlike *Klein*, this petition’s merits are weak. *See id.* at 3. Thus, this request for discretionary denial is stronger than the request in *Klein*.

B. Additional Factors Collectively Weigh Against Institution

1. The Petition Relies Extensively on Expert Testimony

The March 26 Memo explains that “[t]he extent of the petition’s reliance on expert testimony” is a factor the Director may use to deny institution. *See* Ex. 2008 at 2. Further, the Patent Office FAQ explains that “extensive reliance on expert testimony and/or reasonable disputes between experts on dispositive issues may suggest that the questions are better resolved” in another tribunal. *See* Ex. 2012. Here, Petitioner relies extensively on expert testimony. Dr. Reinhall’s lengthy declaration—293 paragraphs across 104 pages—is cited over 150 times in the

Petition. This is not the “focused testimony” that the PTAB anticipates from experts.
See Ex. 2012.

Further, the Petition relies on Dr. Reinhall’s declaration to fill in gaps in the alleged prior art. For example, not one of the alleged prior art references relied on in Petitioner’s obviousness grounds discloses an outer shell that “is reversible such that one of the front side or the rear side is oriented above a face of the user when the outer shell is worn by the user” as recited in elements 1[a] and 8[a]. Rather, Petitioner relies on Dr. Reinhall to fill in this gap, citing his declaration in support of its argument that “it would have been an obvious modification to make the ... helmet reversible to capture more sales from users wanting reversible helmets.” Paper 2 at 21, 55 (citing Ex-1002, ¶ 89). Indeed, Petitioner goes so far as to improperly insert this feature in its purported definition of a person of ordinary skill in the art. *See* Paper 2 at 9. Similarly, none of Yan, Daley, or Nesbitt makes any reference to an accessory device that “includes a clip” as recited in claims 2, 4, 9 and 12, and Petitioner instead relies on Dr. Reinhall to address this element. *See* Paper 2 at 29, 31, 35 (citing Ex-1002, ¶¶ 111, 117, 134). As yet another example, neither Yan nor Daley provides any disclosure regarding the materials used to manufacture their respective helmets, and Petitioner relies on Dr. Reinhall to address the “common material” limitations of elements 1[a][i], 1[b], 3, 8[a], 8[b], 10, 17[b], 17[c]. *See* Paper 2 at 19–20, 22–23, 30, 36 (citing Ex-1002, ¶¶ 84, 86, 95, 115–116,

135); *see also* Paper 2 at 33, 50–51 (referring to earlier discussion). While Petitioner misleadingly states that Daley teaches “using plastic injection molding” (Paper 2 at 31), the cited portion of Daley refers specifically to the housing of the **headlight assembly**, not the helmet. *See* Ex-1012 at 4:61–66. Regarding the helmet itself, Dr. Reinhall merely opines that “the common material being plastic would have been obvious to a POSA as plastic safety helmets predate the ’327 Patent.” *See* Ex-1002, ¶¶ 115–116; *see also id.*, ¶ 135.

The Petition’s extensive reliance on expert testimony weighs heavily in favor of denying institution.

2. *The Relatively Early challenge of the ’327 Patent is not a Significant Factor*

Consistent with the Board’s approach in *NeoGenomics Laboratories, Inc. v. Natera, Inc.*, IPR2025-00455, Paper 13 (June 12, 2025) (discretionarily denying a petition challenging U.S. Patent No. 11,319,596, issued May 3, 2022), the relatively recent issuance of U.S. Patent No. 11,452,327, September 27, 2022, does not constitute a significant factor in the discretionary denial analysis whereas here:

- Trial in the parallel proceeding will occur well before the PTAB’s final written decision,
- The parties and the tribunal have already made substantial investments in the parallel proceeding, and

- There is no indication that the parallel proceeding will be stayed in favor of the IPR.

In such circumstances, the efficiency, avoidance of duplicative proceedings, and respect for the investment in the parallel forum are paramount. The recency of the patent, standing alone, does not outweigh these considerations and should not preclude discretionary denial of institution.

3. *That an ITC Invalidity Ruling Would Not Bind the Office or the Courts Does Not Weigh Against Denying Institution*

As *Fintiv* noted, “as a practical matter, it is difficult to maintain a district court proceeding on patent claims determined to be invalid at the ITC.” *Fintiv*, IPR2020-00019, Paper 11 at 9. Despite awareness of the well-known non-binding nature of ITC invalidity rulings, the Board has found that a parallel ITC case can be the basis for discretionary denial. *Id.*; *see also* Ex. 2013. (March 24, 2025 memorandum from Chief Judge Boalick); *Intel Corp. v. Koninklijke Philips N.V.*, IPR2021-00328, Paper 16 at 6-7 (Mar. 29, 2022) (“non-binding effect of the ITC’s decision” did not “turn” *Fintiv* factor 6 to “strongly weighing” in favor of institution) (emphasis original); *supra* § III (collecting cases where institution was discretionarily denied based on a parallel ITC investigation).

4. *The Settled Expectations Factor Should Tip in Favor of Denial of Institution*

The March 26 Memo states that one factor for consideration is “[s]ettled expectations of the parties, such as the length of time the claims have been in force.” Ex. 2008 at 2. However, the Director has held that this factor favors denial where a Petitioner challenges a recently issued patent (2024) but “has not offered a stipulation to address concerns of duplicative efforts and potentially conflicting decisions in view of a significantly earlier trial date in a co-pending case that is unlikely to be stayed.” *Phison Electronics Corporation v. Vervain, LLC*, PGR2025-00011, Paper 14 at 3 (Jul. 10, 2025). The same circumstances are present here. Accordingly, as in *Phison*, this factor should “tip[] ... in favor of discretionary denial.” *See id.*

5. *Petitioner Has Not Requested Review of all Four Patents Involved in the ITC Investigation*

The March 26 Memo states that the Director may consider “[a]ny other consideration[] bearing on [her] discretion.” Ex. 2008 at 3. There are four patents at issue in the Parallel ITC Investigation (Ex. 2009) but Petitioner has only requested review of three of those patents (IPR2025-00724, IPR2025-00892, PGR2025-00048). Consequently, (1) the ITC is even more unlikely to issue a stay (if one were requested) since the proceedings before the PTAB would not completely resolve the validity issues and, relatedly, (2) the ITC will be tasked with resolving validity issues related to the fourth patent regardless of whether the three trials are instituted.

C. The Office Has Already Considered Many of the Petition's Arguments and Rebuttal Evidence of Non-Obviousness

The Director should also deny institution under 35 U.S.C. § 315(d) because proceeding with an IPR would be an inefficient use of the Board's resources where, as here, prior art and arguments substantially the same as those raised by Petitioner were already considered by the Patent Office, and Petitioner has not established that the Patent Office erred in a way material to patentability.

Discretionary denial under Section 315(d) follows a two-step test:

- (1) whether the *same or substantially the same art* previously was presented to the Office or whether *the same or substantially the same arguments* previously were presented to the Office; and
- (2) if either condition of first part of the framework is satisfied, whether *the petitioner* has demonstrated that the Office erred in a manner material to the patentability of challenged claims.

Advanced Bionics, IPR2019-01469, Paper 6 at 8 (emphasis added). If the same or substantially the same art *or* arguments were previously considered under *Advanced Bionics* step 1, “and the petitioner fails to make a showing of material error” under step 2, “the Director generally will exercise discretion not to institute *inter partes* review.” *Id.* at 8-9.

Both steps support denial. **First**, substantially the same art or arguments as those raised by Petitioner were considered by the Examiner during prosecution of this patent. **Second**, Petitioner failed to show that the Office erred in a manner material to patentability when it allowed the '327 Patent over the already-considered references and arguments.

1. The Obviousness Rationale for Modifying Yan in Grounds 1 and 3 is Substantially the Same as the Obviousness Rationale for Modifying Ramey Considered by the Patent Office During Examination

Each of the challenged claims require, among other things, a front receptacle having a protruding nub “wherein the protruding nub [is] integrally molded with the outer shell” of the helmet. To address this limitation, the Petition asserts for both Grounds 1 and 3 that, upon review of secondary references Daley (Ground 1) and Nesbitt (Ground 3), a POSA would have been motivated “to modify each of Yan’s snap-fit slot structures to be molded to the helmet body” because forming those features from a common material would have been cheaper, easier, *etc.* Paper 2 at 12-13 (Ground 1) and 48-49 (Ground 3). This is substantially the same obviousness rationale the examiner asserted in support of combining Ramey and Theisen in the November 2021 Office Action. Ex-1004 at 126-134. That rejection was successfully traversed during prosecution and the challenged claims were allowed. *See* § II.B above.

In the November 2021 Office Action, the Examiner explained that Ramey teaches a safety helmet including a front receptacle but acknowledged that “Ramey fails to teach the front receptacle includ[es] a protruding nub, wherein the protruding nub is a unitary feature of the outer shell or wherein the outer shell forms the protruding nub.” Ex-1004 at 128. In an effort to resolve this deficiency, the Examiner relied upon Theisen’s disclosure of a molded embodiment of a safety helmet having a protrusion element “formed by the outer shell” of the helmet, concluding that “[r]eplacing the attachment receptacles of Ramey with the molded attachment receptacles of Theisen creates a helmet with multiple integrally molded attachment receptacles.” *Id.* at 127-30.

During the March 2022 Interview, the Examiner and Applicant discussed ways to overcome the obviousness rejection of Ramey and Theisen “by detailing that the outer shell and the nub are formed of the same unitary/integral material”. *Id.* at 84. Following through with those discussions, Applicants filed the April 2022 Response (i) amending the claims to clarify that the protruding nub is “integrally molded with the outer shell” and (ii) presenting the Hill declaration as rebuttal evidence that replacing the attachment receptacles of Ramey with the molded attachment receptacles of Theisen would not have been obvious. *Id.* at 42-81.

The Hill declaration provided the Examiner with a factual basis to conclude that replacing the attachment receptacles of Ramey with the molded attachment

receptacles of Theisen was not an obvious modification, reasoning that a POSA would not make the modification “because the integral molding of structures and features requires the addition of molding aids such as fillets, draft angles to permit mold separation, gentle radii, plastic flow, cooling rates, and other parameters and considerations.” *Id.* at 112. The Examiner was persuaded by Applicant’s argument and the Hill declaration and allowed the application on May 12, 2022. *Id.* at 18-20.

The Petition fails to acknowledge that the obviousness rationale for modifying Yan in Grounds 1 and 3 is substantially the same as the obviousness rationale for modifying Ramey considered during examination and successfully rebutted by Applicants. Moreover, the Petition fails to explain why allowing the claims over Ramey was in error. Although Petitioner argues that the Hill declaration’s written description analysis was flawed, the Petition does not challenge the declaration’s rebuttal evidence of non-obviousness. *See id.* at 79. Instituting trial to revisit the same obviousness arguments considered and rebutted during examination would be a waste of the PTAB’s resources.

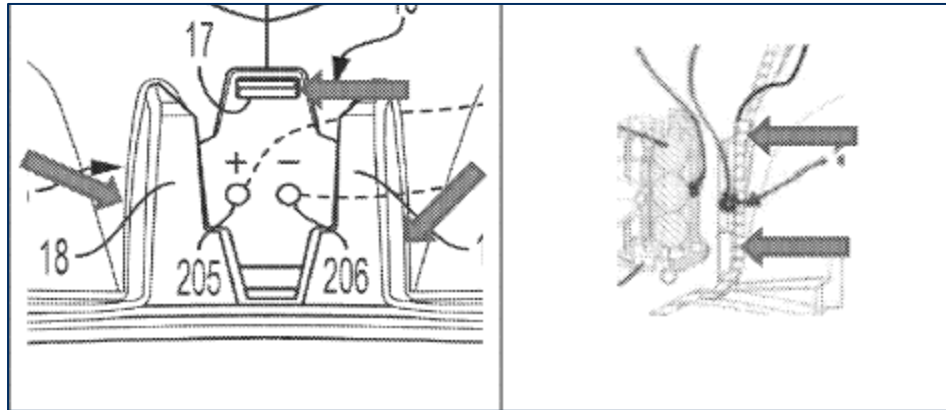
2. *The Priority Date of the Challenged Claims Was Considered by the Examiner*

As discussed above in § IV.A.6, Petitioner’s anticipation argument hinges on its assertion that “the priority date for the Challenged claims is no earlier than October 21, 2021.” Paper 2 at 74. However, the Examiner already rejected this

argument, as Petitioner tacitly acknowledges. Paper 2 at 69 (“Patent Owner relied on the Hill Declaration to validate the addition of new matter.”).

In the November 2021 Office Action, the Examiner rejected the then-pending claims under 35 U.S.C. § 112 because the “[t]here was no support in the originally filed disclosure or the disclosure of provisional applications 62/622,472 and 62/645,491, for the protruding nub being a unitary feature of the outer shell.” Ex-1004 at 123. However, the Applicant traversed this rejection by pointing to line-drawings sourced from the earliest-filed provisional application,⁴ which was filed well before July 23, 2019:

⁴ Petitioner complains that the figures from the Hill declaration are from the ’327 Patent’s non-provisional application. *See* Paper 2 at 70-73. But Petitioner ignores that these figures are the same as the figures in the provisional application, except for slightly different reference lines included. *Compare* Ex-1004 at 45, Fig. 8 *with* ’472 Provisional (Ex-1005), Figs. 3, 4, ’491 Provisional (Ex-1006) Fig. 5; *compare* ’935 Application (Ex-1007), Fig. 3 *with* ’472 Provisional (Ex-1005), Fig. 5, ’491 Provisional (Ex-1006), Fig. 3. Moreover, the allegedly anticipatory reference still post-dates the non-provisional application figures.



See Ex-1004 at 45. The Examiner agreed and withdrew the § 112 objection, allowing the claims. *Id.* at 18-20.

The Examiner's reliance on the Hill declaration was not in error or legally improper. Under 37 C.F.R. 1.132, the Patent Office is mandated to consider declarations: "[w]hen any claim of an application or a patent under reexamination is rejected or objected to, any evidence submitted to traverse the rejection or objection on a basis not otherwise provided for must be by way of an oath or declaration under this section." Further, the MPEP informs that the underlying basis for a Rule 1.132 opinion may be persuasive. MPEP section 716.01(c) (citing *In re Chilowsky*, 306 F.2d 908 (CCPA 1962) (facts supporting a basis for deciding that the specification complies with 35 U.S.C. 112 are entitled to some weight)). Indeed, the Examiner made a factual finding that the Hill declaration conclusion is consistent with the Specification:

This conclusion is consistent with and reinforced by the photos appearing in Figures 12 and 13, which indicate to Mr. Hill that the front

and rear receivers shown in the photos (of the provisional applications, and also the line drawings submitted herewith), based on an observation of the photos and specifically the material color, finish, and fit of the receiver onto the shell, indicate that they are molded together out of the same plastic material using the same mold during the same molding operation.

Ex-1004 at 74. The Examiner's reliance on the Hill Declaration thus does not constitute material error. Even if "reasonable minds" could disagree with whether the two provisional applications and the originally-filed non-provisional application provide support for the protruding nub being a unitary feature of the outer shell limitation (and Patent Owner submits that the support is unassailable), "it cannot be said that the Office erred in a manner material to patentability." *Advanced Bionics*, IPR2019-01469, Paper 6 at 9.

V. CONCLUSION

It would be a highly inefficient waste of the limited resources of the Board and the parties to institute a trial that would not be completed until well after the Parallel ITC Investigation has ended. Moreover, many of Petitioner's arguments were already considered and rejected by the Office, but Petitioner has not established that the Office erred in any material way. Institution should be denied under 35 U.S.C. §§ 314(a) and 325(d), *Fintiv*, *Advanced Bionics*, and the March 26 Memo.

Case No. IPR2025-00724
U.S. Patent No. 11,452,327

Date: July 18, 2025

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CERTIFICATION UNDER 37 C.F.R. § 42.24(d)

Under the provisions of 37 C.F.R. § 42.24(d), the undersigned hereby certifies that the word count for the foregoing Patent Owner Preliminary Response totals 7,460 words as counted by Microsoft Word 2016, the word-processing system used to prepare this paper, which is less than the 14,000 words allowed under 37 C.F.R. §§ 42.24(a)(1)(i) and 42.24(b)(1), exclusive of caption page, the table of contents, the table of authorities, the certificates of service and of word count, and the table of exhibits.

Date: July 18, 2025

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a complete copy of the foregoing document was served on July 18, 2025 on counsel of record for the Petitioner via email to the following addresses:

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